UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,437	04/11/2006	Satomi Kunieda	20027/0203865-US0	8953

7278 7590 07/13/2009

DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

EXAMINER	
DEES, NIKKI H	
ART UNIT	PAPER NUMBER
1794	
MAIL DATE	DELIVERY MODE
07/13/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,437	KUNIEDA, SATOMI	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed May 14, 2009, has been entered. Claims 3-18 are currently pending in the Application. Claims 1 and 2 have been cancelled. The previous objection to claim 5 has been withdrawn in view of Applicant's amendment to claim 5.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. All of claims 3-18 claim a "body enhancer." It is not clear what the "body" is that Applicant refers to, and it is unclear what Applicant intends the claims to encompass.

5. All of claims 8, 10, 13, 15, and 17 further claim a "body-enhancing amount" of the body enhancer to be present in a foodstuff. It is unclear how much of the body enhancer is required to be present in order to enhance the body of the foodstuff. It is further unclear how the enhancing of the "body" of a foodstuff differs from the enhancing of the flavor of a foodstuff.

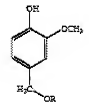
Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3-6 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (US 2002/0013235 A1).

8. Ishida et al. teach the compound below, wherein R represents a C_{1-6} alkyl. The compound may be used to enhance cooling flavors (Abstract).



A preferred embodiment of the invention is vanillyl-n-butyl ether [0008]. This is the same compound of Applicants claims 2 and 4.

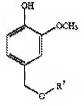
9. The compound may occur in combination with inorganic salts (salty seasonings), as well as flavors and spices. Spices specifically taught include capsaicin and other warming spices, as well as cooling compounds. The compound may be included in foods and drinks [0027], [0032]. A method incorporating the flavor enhancer in foods and beverages is taught in example 8.

10. The claims to a body enhancer and a method for enhancing the body occur in the preamble. As the intended use of the compound as a flavor enhance does not impart any structural difference to the claimed compound, the compound of the prior art is considered to meet the instant claims to a flavor enhancer and a method for enhancing the flavor of a food or beverage.

11. Where the claims comprise an amount of the compound to enhance the body of a foodstuff, these enhancing effects are considered an inherent result of the presence of the compound of Formula 1 in combination with the other flavors as required by claim 3. Therefore, the prior art where the compound of formula 1 is added to foodstuffs in combination with other flavors as detailed above is considered to anticipate Applicant's claims 3-6 and 8-16.

12. Claims 3-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumamoto et al. (US 2002/0119231 A1).

13. Kumamoto et al. teach the compound below for inclusion in foods and drinks



They specifically teach the embodiment where R^7 is 4 carbon atoms, vanillyl butyl ether [0030], [0031].

14. The compound may be used in foods and drinks in combination with a large number of flavorings and spices, as well as sugars. Though not specifically taught as salty or umami flavors, meat extracts are included in the flavors for inclusion in the foodstuff. Other flavors specifically taught include ginger and pepper flavor [0041], [0044].

15. The claims to a flavor enhancer and a method for enhancing the flavor occur in the preamble. As the intended use of the compound as a flavor enhance does not impart any structural difference to the claimed compound, the compound of the prior art is considered to meet the instant claims to a flavor enhancer and a method for enhancing the flavor of a food or beverage.

16. Where the claims comprise an amount of the compound to enhance the body of a foodstuff, these enhancing effects are considered an inherent result of the presence of the compound of Formula 1 in combination with the other flavors as required by claim 3. Therefore, the prior art where the compound of formula 1 is added to foodstuffs in combination with other flavors as detailed above are considered to anticipate Applicant's claims 3-18.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 7, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (US 2002/0013235 A1).

19. Ishida et al. teach the compound of Formula 1 in combination with salty seasonings and other flavors and/or spices as detailed above.

20. They are silent as to the compound being present in combination with umami seasonings.

21. As Ishida et al. teach the compound of Formula 1 for use in combination with a number of different flavoring agents [0027, 0028], it would have been obvious for one of ordinary skill in the art at the time the invention was made to have utilized it in combination with umami flavoring agents. It is considered obvious to utilize known compounds for their intended use to provide the predictable result of the desired flavor, in this case umami. The combination of the compound of Formula 1 with an umami flavoring and other flavors is considered obvious where Formula 1 is taught to be used in combination with a number of types of flavorings in a variety of foodstuffs.

Response to Arguments

22. Applicant's arguments filed May 14, 2009, have been fully considered but they are not persuasive.

23. Applicant argues (Remarks, p. 6) that neither Ishida or Kumamoto teaches the claim elements "as arranged in the claims."

24. The Examiner respectfully disagrees. Ishida clearly teaches the compound of Formula 1 at [0008]. This compound is provided in combination with salty ingredients [0027] and flavors and or spices [0032], clearly anticipating Applicant's claims as detailed above.

25. With regard to Kumamoto, Applicant's claimed compound is taught at [0030,0031] in combination with meat extracts (umami flavors) and salty flavors, as well as other flavors and spices [0041, 0044]. Again, these teachings clearly anticipate Applicant's claims to a "body enhancer," foodstuff comprising said enhancer and a method for enhancing a foodstuff by adding the "body enhancer."

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H. D./
/Lien T Tran/
Primary Examiner, Art Unit 1794

Nikki H. Dees
Examiner
Art Unit 1794